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OFFICE OF PETITIONS

In re Application of :
Casati et al. : DECISION GRANTING PETITION
Application No. 10/032,363 :
Filed: December 21, 2001 :
Atty Docket No. 10013644-1 :

This is in response to the PETITION TO THE DIRECTOR UNDER 37 CFR §1.181 - PETITION TO WITHDRAW HOLDING OF ABANDONMENT, filed September 29, 2010.

By Notice of Abandonment mailed August 9, 2010, applicants were advised that the application was abandoned in view of the decision by the Board of Patent Appeals and Interferences (BPAI) rendered on March 16, 2010, and because the period for seeking court review of the decision had expired and there are no allowed claims. Moreover, as discussed in the Miscellaneous Communication mailed July 30, 2010, the amendment filed May 17, 2010 was not entered.

Petitioner argues that the Examiner incorrectly applied the guidelines of MPEP §1214.01(1) in refusing to enter the claim amendments submitted on May 17, 2010, or in the alternative, the Examiner incorrectly applied 37 CFR §41.50(b)(1) in refusing to allow the Applicants to correct the error under 37 CFR §1.135(c).

Petitioner's arguments have been considered, and the record reviewed in light of the relevant rules. Withdrawal of the holding of abandonment is warranted. As stated in MPEP 1214.01:

When the Board makes a new rejection under 37 CFR 41.50(b), the appellant, as to each claim so rejected, has the option of:

- (A) reopening prosecution before the examiner by submitting an appropriate amendment and/or new evidence (37 CFR 41.50(b) (1)); or
- (B) requesting rehearing before the Board (37 CFR 41.50(b) (2)).

37 CFR 41.50(b) (1) provides that the application will be remanded to the examiner for reconsideration if the appellant submits "an appropriate amendment" of the claims rejected by the Board, "or new evidence relating to the claims so rejected, or both." ... If the appellant submits an argument without either an appropriate amendment or new evidence as to any of the claims rejected by the Board, it will be treated as a request for rehearing under 37 CFR 41.50(b) (2).

In this instance, appellant attempted to reopen prosecution by filing an amendment pursuant to 37 CFR 41.50(b) (1). The examiner determined the amendment was not appropriate and issued a Notice of Abandonment. This course of action is inconsistent with the rules, as discussed above. The Examiner is to make the determination as to whether the amendment is appropriate; however, if he determines that the amendment is not appropriate the course of action is not to issue a Notice of Abandonment, but rather to return the application file to the Board for consideration of the amendment as a request for rehearing under 37 CFR 41.50(b) (2).

Accordingly, the holding of abandonment is hereby WITHDRAWN.

The petition under § 1.181 is GRANTED.

No fee is required on petition under § 1.181.

Technology Center AU 2654 has been advised of this decision. This decision calls for the withdrawal of the holding of abandonment and for consideration by the examiner of the amendment filed May 17, 2010, at least insofar as the amendment relates to the claims rejected by the BPAI pursuant to 37 CFR 41.50(b), and any other appropriate action in light of this decision.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3219.



Nancy Johnson
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Office of Petitions